

REMARKS

Applicants thank the Examiner for the courtesy extended to Applicants' attorney during the interview held September 11, 2006, in the above-identified application. During the interview, Applicants' attorney explained the presently-claimed invention and why the below-discussed rejections are not well-taken. The discussion is summarized and expanded upon below.

The rejection of Claim 8 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. Claim 8 had been previously amended (and Claim 20 added) to refer to the claimed substrate as substrate 3, to distinguish it from the substrates that are part of the multicoat system of Claim 1, as discussed at page 7 of the amendment filed May 12, 2006. Applicants believe that the amendment was clear. During the above-referenced interview, the Examiner requested that Applicants repeat their reasoning for making the above-discussed amendment. If the Examiner still finds the claim objectionable, Applicants have no objection, if this is the remaining ground of rejection, to the Examiner deleting "3" in Claim 8 (and Claim 20) by Examiner's Amendment. Accordingly, it is respectfully requested that the rejection be withdrawn.

The rejection of Claims 1-9 and 16-24 under 35 U.S.C. § 112, second paragraph, is respectfully traversed.

As recited in Claim 1, an embodiment of the present invention is a multicoat system, on a substrate 1 (A), comprising at least one radiation-curable coating system (F), optionally, at least one coat (E), which is pigmented and/or provided with effect substances, and which is adjacent to and under (F), said coating system (F) and optional coat (E) being a topcoat, and at least one elastic intercoat (D), which is located between the substrate and the topcoat, and has a glass transition temperature (T_g) of -20°C or less (measured in the frequency range up to 1000 Hz), wherein the multicoat system has an impact strength to DIN EN ISO 179/1fU at

23°C and 50% humidity of at least 20 kJ/m², and the ratio (V) of the intercoat thickness (ZS) to the total thickness of the intercoat and the topcoat (DL), expressed as $V = ZS/(ZS + DL)$, in the multicoat system, is at least 0.05 at a temperature of at least 25°C.

As described in the specification beginning at page 1, line 10, the present invention is drawn to solving a problem that especially arises in hard coatings, wherein a microcrack initiated in the coating propagates with a very high degree of local definition through the coating into the substrate to which the coating material is applied. Applicants have been able to obtain highly scratch-resistant, radiation-curable coating systems having improved fracture-mechanical properties, with good adhesion to the substrate at the same time as reduced crack propagation into the substrate.

The Examiner cites *Ex parte Slob*, 157 USPQ 172 (BdPatApp&Int 1968) as supporting a finding that the claims are vague and indefinite because they cover everything which will perform the desired function regardless of its composition. In reply, *Slob* involved an issue with respect to the expression “a liquefiable substance having a liquefaction temperature from about 40°C, to about 300°C, and being compatible with the ingredients in the powdered detergent composition.” The Board found that the above-quoted term “purports to cover everything which will perform the desired functions regardless of its composition and, in effect, recites the compounds by what it is desired that they do rather than what they are.” Applicants respectfully submit that the present situation distinguishes over *Slob*.

As Applicants' attorney pointed out during the above-referenced interview, the claims require a particular structural arrangement of layers which layers are defined by their respective functions and/or properties, and which layers make up the claimed multicoat system, the multicoat system having a particular impact strength and ratio (V). The invention is not limited to particular materials that can be used for each layer, although the specification

describes applicable materials for each layer, and some of the dependent claims limit the claimed multicoat system to those which specify particular materials. The invention herein is not with respect to the materials used *per se*, but to the particular arrangement of layers, which result in a multicoat system having superior properties. These properties are demonstrated in the Examples, described in the specification beginning at page 34, line 16. Indeed, one skilled in the art, with no more than routine experimentation, would be able to determine applicable materials for the respective layers beyond the particular materials described in the specification. There is nothing in the patent statutes that would proscribe patentability of such an invention.

There can be no question that the claim scope is definite, since whether subject matter is within or without the terms of the claims is easily verifiable. This can be contrasted to the “liquefiable substance” of *Slob*, which was bounded by a definite temperature range but an indefinite property of being “compatible.”

A more pertinent case is *In re Fuetterer*, 319 F.2d 259, 138 USPQ 217 (CCPA 1963) (copy enclosed).

Note finally, and as Applicants’ attorney pointed out during the above-referenced interview, in the absence of prior art, it is manifestly unjust to require limiting of the claims to the exemplified material described for each layer, since it would invite any would-be pirate to use a material not specifically disclosed and thereby infringe the claims with impunity. Nor does case precedent require that Applicants do so.

For all the above reasons, it is respectfully requested that the rejection be withdrawn.

The rejection of Claims 1-9 and 16-24 under 35 U.S.C. § 112, first paragraph, as failing to comply with the description requirement, is respectfully traversed. The Examiner finds that the equation in Claim 1 is not supported by the original disclosure.

In reply, the equation is described in the specification at page 33, lines 18-27.

Applicants note, also, that during the above-referenced interview, the Examiner could not recall the rationale behind this rejection. Accordingly, it is respectfully requested that the rejection be withdrawn.

In the amendment filed May 12, 2006, Applicants alerted the Examiner to the fact while paragraph 2 of the Office Action entered March 21, 2006 states that initialed copies of corresponding Form PTO-1449s for Information Disclosure Statements (IDSs) filed July 11, 2005 and January 12, 2005 were enclosed with the Office Action, Applicants noted that **no** initialed Form PTO-1449 was enclosed. Applicants noted further that only one Form PTO-1449 had been filed, and that was with the IDS filed January 12, 2005. The Examiner was respectfully requested to include the initialed copy with the next Office communication.

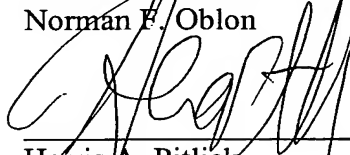
During the above-referenced interview, the Examiner indicated that the prior art cited in the IDS had never been considered. Accordingly, the Examiner must now consider this prior art. Of course, if any of this prior art is relied on in a rejection, the next Office Action cannot be made Final. For the Examiner's convenience, a copy of the above-discussed Form PTO-1449 is **submitted herewith**. The Examiner is again respectfully requested to include an initialed copy with the next Office communication.

Application No. 10/519,841
Reply to Office Action of August 22, 2006

All of the presently-pending claims in this application are now believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Harris A. Pitlick', is written over a horizontal line.

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